

## ***REMARKS***

In response to the Office Action dated September 2, 2005 (“the 8/02/2005 Office Action”), claims 1, 6, 8, 12, 16, 21, 23, 27, 31, 35, 36, 38, 42,44-46, 51, 53, and 57 are currently amended; no claims are newly added or cancelled. Accordingly, claims 1-60 are currently pending in the application. In view of the foregoing amendments and the following remarks, allowance of all the claims pending in the application is requested.

### ***Election/Restriction***

In the 8/02/2005 Office Action, the Examiner alleges that Applicants have previously elected Species 2 (in the Response to Restriction Requirement filed July 11, 2005), and withdraws claims 2-8, 17-23, 32-38, and 47-53 from consideration. However, Applicants did not elect Species 2, explicitly or constructively, but instead traversed the election of species requirement made by the Examiner in the Office Action mailed June 9, 2005 (“the 6/09/2005 Office Action”) as being improper because the two species (Species 1 and Species 2) identified by the Examiner are not independent inventions, as defined by M.P.E.P § 806.4. Applicants hereby maintain the previous traversal of the election of species requirement as being improper.

The election of species requirement is improper because the groups of claims created by the Examiner do not correspond to independent inventions under the definition of independent inventions provided by the M.P.E.P. Section 806.4 of the M.P.E.P. suggests that in instances that include a generic independent claim, claims depending from the generic claim may be drawn to a plurality of independent species when the various species provide similar functionality to the generic independent claim by distinct and independent mechanisms. For instance, § 806.4 provides the example of “a genus of paper clips having species differ in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.”

In the instant application, the election of species requirement is improper because while the Examiner alleges that the dependant claims form two independent species that depend from independent generic claims, the groups of claims identified by the Examiner do not correspond to distinct and independent mechanisms for providing similar functionality. More particularly, FIG. 3 of the instant application illustrates a system that includes elements from both species identified by the Examiner (elements 316 and 318 corresponding to Species 1; and elements 308, 310, and 314 corresponding to Species 2), and the specification

describes these elements as performing different functions within the system, not performing the same functions by different mechanisms. *See* the specification at pages 9-11. Therefore, the election of species requirement is improper and should be withdrawn. Accordingly, currently pending claims 2-8, 17-23, 32-38, and 47-53 should be reinstated for consideration.

### ***Specification***

The formal objections to the specification have been obviated by the amendments to the specification presented above.

### ***Claim Objections***

The formal objections to claims 12, 27, 35, 42, 44, 45, and 57 are moot in light of the amendments to the claims presented in the **Listing of the Claims** provided above.

### ***Rejections Under 35 U.S.C. § 101***

The Examiner has rejected claims 1, 9-16, 24-31, 39-46, and 54-60 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. More specifically, the Examiner contends that these claims raise a question as to whether the claims are tied to a technological art, environment or machine. Subsequent to the 8/02/2005 Office Action, the Board of Patent Appeals and Interferences (“the BPAI”) has ruled that there is “no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under § 101.” *Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005). Accordingly, these rejections should be withdrawn.

### ***Rejections Under 35 U.S.C. § 102***

#### **Rejection based on “Vivacqua”**

The Examiner has rejected claims 1, 9, 13, 15, 16, 24, 25, 28, 30, 31, 39, 40, 43, 45, 46, 54, 55, 58, and 60 under 35 U.S.C. § 102(b) as allegedly being anticipated by “Agents to Assist in Finding Help” (citation omitted), by Vivacqua *et al.* (“Vivacqua”). In response to the rejection, Applicants have amended independent claims 1, 16, 31, and 46 to further clarify various aspects of the invention. Based in part on these amendments, as well as for features present in the independent claims prior to the amendments of this paper, Applicants disagree with these rejections at least because Vivacqua does not disclose all of the features of the claimed invention.

More particularly, claim 1 recites, *inter alia*, “determining a user affinity for the category based on the number of times that actions are performed on the at least one object by the at least one user and the values associated with the action types of the actions performed on the at least one object by the at least one user.” Independent claims 16, 31, and 46 include similar subject matter, among other things.

In contrast, Vivacqua describes a system in which only a single type of action is monitored, namely, the authoring of java source code files. Since the system of Vivacqua only accounts for a single type of action, Vivacqua does not disclose values associated with different types of actions, or determining a user affinity based in part on the values associated with the types of actions performed by a user. For at least this reason, the rejection of claims 1, 16, 31, and 46 based on Vivacqua should be withdrawn. Further, claims 9, 13, 15, 24, 25, 28, 30, 39, 40, 43, 45, 54, 55, 58, and 60 depend from corresponding ones of claims 1, 16, 31, and 46, and therefore, are allowable over Vivacqua based on their dependency as well as for the features that they add to the independent claims.

Rejection based on “Newbold”

The Examiner has rejected claims 1, 9, 14-16, 24, 29-31, 39, 44-46, 54, 59, and 60 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0087600 to Newbold (“Newbold”). Applicants traverse this rejection on the grounds that Newbold does not qualify as prior art under § 102(e).

Newbold does not qualify as prior art under § 102(e) because at the time the claimed invention disclosed in this patent application was made, both Newbold and the claimed invention were assigned (or subject to an obligation of assignment) to International Business Machines Corporation. Therefore, the common assignee exception applies. For *at least* these reasons, the rejection of claims 1, 9, 14-16, 24, 29-31, 39, 44-46, 54, 59, and 60 is improper and should be reversed.

***Rejections Under 35 U.S.C. § 103***

The Examiner has rejected claims 11, 12, 26, 27, 41, 42, 56, and 57 under 35 U.S.C § 103(a) as being unpatentable over Vivacqua in view of U.S. Patent No. 6,832,224 to Gilmour (“Gilmour”). Applicants disagree with this rejections at least because the cited references do not teach or suggest all of the features of the claimed invention.


The Examiner acknowledges that Vivacqua fails to teach decaying the user affinity at a constant rate. The Examiner relies on Gilmour for this feature. However, Gilmour does not solve the deficiency of Vivacqua discussed above. More particularly, while Gilmour discloses determining confidence levels between topics and users based on emails sent and received by the users, Gilmour does not suggest determining the confidence levels based on values associated with types of actions (*e.g.*, sending, receiving, *etc.*) performed on the emails by the users. Therefore, the combination of Vivacqua and Gilmour is deficient at least for failing to teach or suggest determining a user affinity for the category based on the number of times that actions are performed on the at least one object by the at least one user and the values associated with the action types of the actions performed on the at least one object by the at least one user. For at least this reason, the rejection of claims 11, 12, 26, 27, 41, 42, 56, and 57 is improper and should be withdrawn.

***Conclusion***

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: December 2, 2005

Respectfully submitted,



James G. Gatto  
Registration No.: 32,694

PILLSBURY WINTHROP SHAW PITTMAN LLP  
P.O. Box 10500  
McLean, Virginia 22102  
Phone: 703-905-2000  
Fax: 703-905-2500